



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: HORTON, Robert L. *et al.*

Serial No.: 10/605188

Filed: 09/12/2003

For: REMEDIATION TREATMENT OF SUSTAINED  
CASING PRESSURES (SCP) IN WELLS WITH  
TOP DOWN SURFACE INJECTION OF FLUIDS  
AND ADDITIVES

Group Art Unit: Not Assigned

Examiner: Not Assigned

Attorney Docket: 11836.0741.NPUS01  
(PA-00408US)

**PETITION UNDER 37 C.F.R. § 1.47(a) FOR ACCEPTANCE OF APPLICATION  
WHERE JOINT INVENTOR REFUSES TO JOIN IN APPLICATION FOR PATENT  
(FILED CONCURRENTLY WITH RESPONSE TO MISSING PARTS)**

**MAIL STOP MISSING PARTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

The above-captioned patent application was filed with the United States Patent Office on September 12, 2003, and has been assigned application Serial No. 10/605,188. No amendments have been submitted and no Office Actions on the merits have been received. Applicants' attorney received a "Notice to File Missing Parts of Application - Filing Date Granted" that was mailed on December 8, 2003, because an inventor's declaration was not submitted with the

application. The assignee of this patent application, M-I LLC, has not been able to obtain the required declaration because one of the joint inventors, Mr. John Powell, has refused to sign it.

Under 37 CFR 1.47(a) the oath or declaration must be accompanied by a petition including proof of the pertinent facts, the fee set forth in 1.17(h), and the last known address of the nonsigning inventor. *See also* MPEP §409.03.

Accordingly,

1. The duly-signed declarations of the other joint inventors are attached with the signature block of the nonsigning inventor left blank so that the declaration may be treated as having been signed by all of the available joint inventors on behalf of the nonsigning inventor. *See* MPEP §409.03(a).

2. A declaration of Carter J. White, Patent Counsel for M-I L.L.C. is attached in support of this petition and as proof of the pertinent facts.

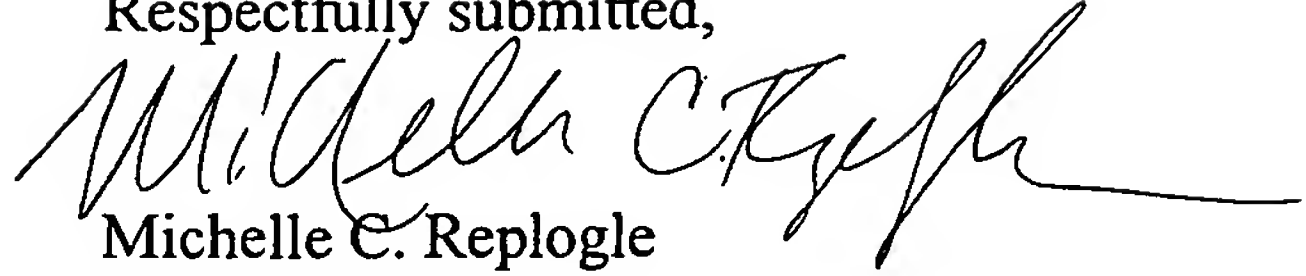
3. The Commissioner is authorized to deduct the fee required under 37 C.F.R. § 1.17(h) from Howrey Simon Arnold & White, LLP Deposit Account No. 01-2508/11836.0741.NPUS01.

4. The last known address is as follows:

Mr. John Powell  
The Whitney  
60 Poydras St.  
New Orleans, LA 70130

Applicants respectfully request acceptance of the application under 37 C.F.R. § 1.47(a). Should any additional fees be deemed necessary for any reason relating to this document, the Commissioner is hereby authorized to deduct said fee from Howrey Simon Arnold & White, LLP Deposit Account No. 01-2508/11836.0741.NPUS01.

Respectfully submitted,



Michelle C. Replogle

Patent Attorney

Reg. No. 54,394

Tel. 713.787.1535

Attorney for Applicants

HOWREY SIMON ARNOLD & WHITE, LLP

750 Bering Drive

Houston, Texas 77057

(713) 787-1400

Date: 5-4-04

CARTER J. WHITE  
Patent Counsel  
Legal Department



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: HORTON, Robert L. et al.

Serial No.: 10/605188

Confirmation No.: 2187

Filed: 09/12/2003

For: REMEDIATION TREATMENT OF SUSTAINED  
CASING PRESSURES IN WELLS WITH TOP  
DOWN SURFACE INJECTION OF FLUIDS AND  
ADDITIVES

Group Art Unit: Not Assigned

Examiner: Not Assigned

Atty. Dkt. No.: 11836.0741.NPUS00  
(PA-00408US)

**DECLARATION OF CARTER J. WHITE  
IN SUPPORT OF PETITION UNDER 37 C.F.R. § 1.47(A)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

I, Carter J. White, hereby declare the following:

1. I am currently employed as Patent Counsel for M-I L.L.C., a Delaware Corporation having a business address of 5950 North Course Drive, Houston, TX 77072. I am licensed to practice law in the States of Texas and California and registered to practice before the U.S. Patent and Trademark Office. At the time of each of the following occurrences, I was employed as Patent Counsel for M-I L.L.C.

2. On or about April 12, 2004 I mailed a letter via Certified Mail – Return Receipt Requested including both a declaration document and a copy of the patent application to the last known address of Mr. John Powell. A true copy of this letter is attached as Exhibit A to this

document. Included in the April 12, 2004 letter is a request that Mr. Powell review the patent application and execute the declaration document in compliance with the terms and obligations of Mr. Powell's employment by M-I L.L.C. at the time of the conception of the invention.

3. On or about April 20, 2004, I received a signed Domestic Return Receipt indicating receipt of the letter as addressed. A true copy of this document is attached as Exhibit B to this document.

4. On or about April 26, 2004, at approximately 11:30 AM, I received a telephone call from a person identifying himself as Mr. John Powell. Mr. Powell confirmed to me that he had received my letter of April 12, 2004 including the patent application and declaration documents. Mr. Powell stated that after his review of the papers, he did not believe that he was an inventor of the claimed subject matter. Mr. Powell stated that the basis for this belief was that "this is nothing new" and that it was known and being done "by everyone in the industry." Mr. Powell also stated that "There is no reason to pursue a useless patent if M-I is not willing to market and sell the technology." I indicated to Mr. Powell that M-I intended to pursue the patent application, and that we would like him to sign the papers. In response Mr. Powell said, "M-I can do whatever it wants, but I'm not going to sign these papers."

5. At the conclusion of my telephone conversation with Mr. Powell, Mr. Powell indicated to me that the invention was known back in 1991 as the M-I product Casing Pack. Further Mr. Powell alleged that this same fluid was used 'on numerous wells for B-P and ARCO.' I asked Mr. Powell if he could please send me any information to support these

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Serial No.: 10/605188  
Confirmation No.: 2187  
Applicant: HORTON et al.  
Atty. Ref.: 11836.0741.NPUS00

statements. In response, Mr. Powell agreed that he would send me the supporting information and that he would also send me information about a company located in Mandeville, Louisiana that he said had been using the technology for years. As of the date of this statement, I have not received this information.

I hereby declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,



Carter J. White  
Patent Attorney  
Reg. No. 41,374

Tel. 281 561 1450  
Fax. 281 561 1452  
Email: cjwhite@midf.com

Date: 4 May 04



**U.S. Postal Service**  
**CERTIFIED MAIL RECEIPT**  
(Domestic Mail Only; No Insurance Coverage Provided)

NEW ORLEANS, LA 70130

Postage	\$ 1.52	UNIT ID: 0057
Certified Fee	2.30	
Return Receipt Fee (Endorsement Required)	1.75	
Restricted Delivery Fee (Endorsement Required)		
Total Postage & Fees	\$ 5.57	

Postmark  
Here

CLERK: KYTG58

04/12/04

Sent To

Mr. John Powell

Street, Apt. No.,  
or PO Box No.

The Whitney, 60 Poydras St

City, State, ZIP+4

New Orleans, LA 70130

PS Form 3800, January 2001

See Reverse for Instructions

6918 0255 9000 0152 1002

**MISWACO**

M-I LLC

5950 North Course Drive · Houston, Texas 77072  
Tel: 281-561-1300 · Fax: 281-561-1452 · [www.miswaco.com](http://www.miswaco.com)



Writer's Direct Dial:  
281-561-1450

VIA CERTIFIED MAIL- RETURN RECEIPT

April 12, 2004

Mr. John Powell  
The Whitney  
60 Poydras St.  
New Orleans, LA 70130

Re: U.S. Patent Application Entitled: "Remediation Treatment of Sustained Casing Pressures in Wells with Top Down Surface Injection of Fluids Additives"  
Application No. 10/605188  
Named Inventors: Robert L. Horton; John W. Powell, William E. Foxenberg; David Kippie

Dear Mr. Powell

You have been named as an inventor on the above noted invention which was conceived by you and your co-inventors during your employment by M-I L.L.C. Please find the following documents for your review and signature:

A copy of U.S. Patent Application Entitled: "Remediation Treatment of Sustained Casing Pressures in Wells with Top Down Surface Injection of Fluids Additives"  
Application No. 10/605188; Filed: September 12, 2003  
Named Inventors: Robert L. Horton; John W. Powell, William E. Foxenberg; David Kippie

An Inventor's Declaration for the above noted patent application

An Assignment of Rights for the above noted patent application

In compliance with your obligations under your employment agreement with M-I L.L.C., please sign and return the above documents to the following address:



April 12, 2004  
Page 2

M-I L.L.C.  
Legal Dept. -Patents  
5950 North Course Drive  
Houston, TX 77072

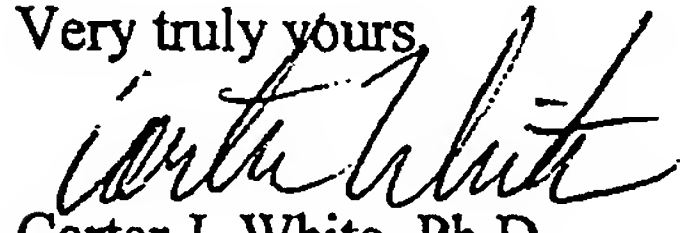
Attention: Carter White

For your convenience I have enclosed a stamped, pre-addressed envelope for this purpose.

Please return the executed papers no later than May 1, 2004, otherwise M-I L.L.C. will consider your non-response a refusal to execute these papers and M-I L.L.C. will pursue the application without your consent.

Should you have any questions regarding this matter, please do not hesitate to contact me.

Very truly yours,

A handwritten signature in cursive script, appearing to read "Carter J. White".

Carter J. White, Ph.D.  
Patent Counsel

Enc.:



PA-0040865

Is your RETURN ADDRESS completed on the reverse side?

**SENDER:**

- Complete items 1 and/or 2 for additional services.
- Complete items 3, 4a, and 4b.
- Print your name and address on the reverse of this form so that we can return this card to you.
- Attach this form to the front of the mailpiece, or on the back if space does not permit.
- Write "Return Receipt Requested" on the mailpiece below the article number.
- The Return Receipt will show to whom the article was delivered and the date delivered.

I also wish to receive the following services (for an extra fee):

1. ☐ Addressee's Address
2. ☐ Restricted Delivery

Consult postmaster for fee.

**3. Article Addressed to:**

Mr. John Powell  
The Whitney  
60 Poydras St.  
New Orleans, LA 70130

**4a. Article Number**

7001 2510 0006 5520 8169

**4b. Service Type**

- |   |   |
|---|---|
| <input type="checkbox"/> Registered                     | <input checked="" type="checkbox"/> Certified |
| <input type="checkbox"/> Express Mail                   | <input type="checkbox"/> Insured              |
| <input type="checkbox"/> Return Receipt for Merchandise | <input type="checkbox"/> COD                  |

**7. Date of Delivery**

**5. Received By: (Print Name)**

Levartus Bagneris

**6. Signature: (Addressee or Agent)**

X

**8. Addressee's Address (Only if requested and fee is paid)**

Thank you for using Return Receipt Service.